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EXAMINER	
KAYES, SEAN PHILLIP	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ATSUSHI ISHII

Appeal 2008-6362
Application 10/738,936
Technology Center 2800

Decided: January 29, 2009

Before ROBERT E. NAPPI, CARLA M. KRIVAK,
and ELENI MANTIS MERCADER, *Administrative Patent Judges*.

MANTIS MERCADER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's rejection of claims 1-13. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

INVENTION

Appellant's claimed invention is directed to "setting an internal clock in a GPS-equipped mobile communication device when the mobile communication device is not in a digital service area" (Spec. 4:6-7) by activating its "GPS receiver to decode a signal from the GPS satellite system" (Spec. 5:3-5) and using GPS time information to adjust its internal clock (Spec. 6:11-13).

Claim 1, reproduced below, is representative of the subject matter on appeal:

1. A method of setting an internal clock in a GPS-equipped mobile communication device when the mobile communication device is not in a digital service area, comprising:

powering-up the mobile communication device;

determining whether digital service is available, and, if digital service is not available, activating a GPS receiver in the mobile communication device;

detecting a GPS time signal from any GPS satellite, and setting the internal clock in the mobile communication device from the GPS time signal.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Brunts	US 5,724,316	Mar. 03, 1998
Lurey	US 6,009,130	Dec. 28, 1999
Garin	US 6,427,120 B1	Jul. 30, 2002

The following rejections are before us for review:

1. The Examiner rejected claims 1, 2, 4-8, and 10-13 under 35 U.S.C. § 103(a) as being unpatentable over Garin in view of Brunts.

2. The Examiner rejected claims 3 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Garin in view of Brunts and Lurey.

OBVIOUSNESS

ISSUE

The Examiner asserts that "[n]o limitation exists requiring the GPS detector to be inactive when digital service is available" (Ans. 13).

Appellant contends that Garin always has a "live" GPS receiver, whereas the method of the invention requires activating the GPS receiver only upon non-receipt of a digital service signal (Br. 4).

The issue before us, then, is as follows:

Has the Appellant shown that the Examiner erred by determining that Garin teaches "determining whether digital service is available, and, if digital service is not available, activating a GPS receiver in the mobile communications device" as recited in claim 1?

FINDINGS OF FACT

The relevant facts include the following:

1. Garin teaches that the wireless communications device comprises a GPS receiver that can be "selectively switched between the standalone mode and at least one other mode for determining a geolocation of the wireless communication device" (col. 2, ll. 37-40).
2. Garin teaches switching to standalone mode when the network traffic is heavy (col. 8, ll. 33-38).

PRINCIPLES OF LAW

The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If that burden is met, then the burden shifts to the Appellants to overcome the prima facie case with argument and/or evidence. *Id.* The Supreme Court, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), stated that "' [r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007).

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994).

ANALYSIS

Has the Appellant shown that the Examiner erred by determining that Garin teaches "determining whether digital service is available, and, if digital service is not available, activating a GPS receiver in the mobile communications device" as recited in claim 1?

Claim 1 recites "determining whether digital service is available, and, if digital service is not available, *activating a GPS receiver* in the mobile communications device" (emphasis added). Garin teaches that the wireless communications device comprises a GPS receiver that can be "selectively switched between the standalone mode and at least one other mode for determining a geolocation of the wireless communication device" (Finding of Fact 1). Garin teaches switching to standalone mode when the network traffic is heavy (Finding of Fact 2). Thus, Garin teaches detecting absence of the digital service and switching to a different mode, but Garin does not teach "activating a GPS receiver" as recited in claim 1. Accordingly, the recited claim 1 limitation of: "if the digital service is not available, *activating a GPS receiver*," is not taught by Garin's always on GPS receiver which switches between different modes (emphasis added).

For the above reasons, Appellant has shown error in the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as well as independent claim 8 which recites commensurate limitations. Furthermore, Brunts and Lurey do not remedy the shortcomings of Garin. We are therefore likewise persuaded of error in the Examiner's obviousness rejections of claims 2-7 and 9-13 under 35 U.S.C. § 103(a) for similar reasons as these claims depend directly or indirectly from independent claims 1 and 8.

CONCLUSION OF LAW

Appellant has shown that the Examiner erred by determining that Garin teaches "determining whether digital service is available, and, if digital service is not available, activating a GPS receiver in the mobile communications device" as recited in claim 1. Appellant has also shown that the Examiner erred in rejecting claims 2-13 over the collective teachings of the cited prior art under § 103.

ORDER

The decision of the Examiner to reject claims 1-13 under 35 U.S.C. § 103(a) is reversed.

REVERSED

ELD

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